

REMARKS

I. Introduction

Claims 1-3, 6-9 and 11-14 are currently pending in the present application. For at least the reasons set forth below, Applicants respectfully submit that the claims are in condition for allowance.

II. Rejections of Claims 1-3, 6-9 and 11-14 under 35 U.S.C. § 112, first paragraph

Claims 1-3, 6-9 and 11-14 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. With respect to claim 1, the Examiner states that the claimed recitation of “the loss of a speed regulating function occurs solely via command of the driver” presents new matter because the specification does not limit the invention with the terminology “solely.” In response, Applicants initially note that the claimed recitation of the term “solely” does present new matter since original claim 1 clearly recited the exact term “solely” (see MPEP 2163.01, which explicitly states that “new matter” issue does not arise in this context). Second, to the extent that the Examiner is contending that the exact, literal term used in the claim has to be used in the specification to meet the written description requirement, Applicants note that this is clearly incorrect: “The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” (MPEP 2163.02). The test for sufficiency of written description is whether the description “conveys with reasonable clarity to those skilled in the art, . . . applicant was in possession of the invention as now claimed.” (MPEP 2163.02). The original specification clearly indicates the following: a) “the Stop & Roll mode has at least one controlling function which is not available in the ACC mode, in particular, a stop function by which the vehicle may be automatically braked to a standstill” (p. 8, l. 5-7); and b) the change to “the ACC mode (state 34) from the S&R mode (state 36) . . . does not take place without the active participation of the driver, and consequently does not occur against the will of the driver” (p. 10, l. 26-31). In view the above-recited description in the original specification, Applicants submit that the original specification fully satisfies the written description requirement for the claimed recitation of “the loss of a speed regulating function occurs solely via command of the driver” in claim 1.

For at least the foregoing reasons, Applicants submit that claim 1 and its dependent claims 2-3, 6-9 and 11-14 are in compliance with 35 U.S.C. § 112, first paragraph, and the

rejection of claim 1 and its dependent claims 2-3, 6-9 and 11-14, based on the alleged failure to satisfy the written description requirement, should be withdrawn

Claims 1-3, 6-9, 11-14 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner contends that “**a loss of a speed-regulating function**” recited in claim 1 is not clear, and that the “disclosure is not clear as to what should be considered ‘a loss.’” First, Applicants note that the meaning of the claimed language is clear from the plain language: “**a loss of a speed-regulating function**” simply means “**a speed-regulating function**” is no longer available, i.e., a speed regulating function that exists in the old operating mode (before the change) does not exist in the new operating mode. Second, the original specification clearly describes this claimed feature: a) “the Stop & Roll mode has at least one controlling function which is not available in the ACC mode, in particular, a stop function by which the vehicle may be automatically braked to a standstill” (p. 8, l. 5-7); and b) the change to “the ACC mode (state 34) from the S&R mode (state 36) . . . does not take place without the active participation of the driver, and consequently does not occur against the will of the driver” (p. 10, l. 26-31). In view of the above-recited description in the original specification, Applicants submit that there is no reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention (“**a loss of a speed-regulating function**”) without resorting to undue experimentation, which negates the Examiner’s enablement rejection. (See MPEP 2161.01 III).

For at least the foregoing reasons, Applicants submit that claim 1 and its dependent claims 2-3, 6-9 and 11-14 are in compliance with 35 U.S.C. § 112, first paragraph, and the rejection of claim 1 and its dependent claims 2-3, 6-9 and 11-14, based on the alleged failure to satisfy the enablement requirement, should be withdrawn.

III. Rejection of Claims 1-3, 6-9 and 11-14 under 35 U.S.C. § 112, second paragraph

Claims 1-3, 6-9 and 11-14 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

In claim 1, the Examiner contends that the claimed feature “the loss of a speed regulating function occurs solely via command of the driver” conflicts with the features that “the decision unit . . . automatically limits the desired speed” and “activated only above a limiting speed.”

Applicants respectfully note that these limitations refer to different regulating situations, and therefore these two limitations do not conflict, as further explained in detail below. First, the claimed feature “**the loss of a speed regulating function occurs solely via command of the driver**” occurs in the context of the phrase “wherein a change in a current operating mode which results in the loss of a speed regulating function occurs solely via command of the driver,” which is clearly explained in the original specification: a) “the Stop & Roll mode has at least one controlling function which is not available in the ACC mode, in particular, a stop function by which the vehicle may be automatically braked to a standstill” (p. 8, l. 5-7); and b) the change to “the ACC mode (state 34) from the S&R mode (state 36) . . . does not take place without the active participation of the driver, and consequently does not occur against the will of the driver” (p. 10, l. 26-31). Second, the recitation that “**the decision unit . . . automatically limits the desired speed**” occurs in the context of the limitation that “the decision unit automatically causes a change from the first operating mode into second operating mode . . . and then automatically limits the desired speed.” As clearly recited in the third paragraph of claim 1, “the second operating mode provides . . . an automatic braking of the vehicle to a standstill,” i.e., **the second operating mode refers to the Stop & Roll (S&R) mode**. Accordingly, when the claimed features are viewed together, there is no conflict: a) “the loss of a speed regulating function occurs solely via command of the driver” refers to the change to “the ACC mode (state 34) from the S&R mode (state 36),” i.e., a change from the second operating mode; b) “the decision unit . . . automatically limits the desired speed” refers to the context in which “a change from the first operating mode into second operating mode” (S&R mode); and c) “activated only above a limiting speed” is recited in the context of the limitation that “a first . . . operating mode for a first predetermined vehicle speed range that is configured to be activated only above a limiting speed,” which does not present any logical conflict with the feature that “the loss of a speed regulating function occurs solely via command of the driver,” which refers to the change to “the ACC mode (state 34) from the S&R mode (state 36),” i.e., a change from the second operating mode.

To the extent the Examiner contends that “a first predetermined vehicle speed range” and “a second predetermined vehicle speed range” are indefinite because “[t]here are no definite bounds that differentiate the speed ranges as claimed,” Applicants respectfully note that there is no legal requirement to state numerical limits to a range in order to satisfy the definiteness requirement. To the extent the Examiner refers to the description on p. 2 of the specification, Applicants note that this section is part of the “Background Information” and does not describe

the present invention. To the extent the Examiner contends that “the limitation ‘a second predetermined speed vehicle speed range that is lower than the first predetermined vehicle speed range’ is not enabled since the ranges overlap and there is no clear distinction between the claimed speed ranges,” Applicants respectfully submit that: a) there is no legal requirement that different speed ranges must not overlap in order to satisfy the definiteness requirement; and b) there is a clear distinction between the claimed speed ranges. As recited in claim 1, the “first operating mode” has “a limiting speed” as the lower limit, which is exemplified by speed Vs for the “ACC” mode in Fig. 2. Furthermore, the “second operating mode” has “an upper limit,” which is exemplified by speed Vs+h1 for the “S&R” mode in Fig. 2. As can be clearly seen in Fig. 2, the “upper limit of the second speed range” (i.e., Vs+h1 for the “S&R” mode) is “at least equal to the limiting speed” (i.e., Vs for the “ACC” mode), and the first speed range permitted for the “ACC” mode (starting from the lower limit Vs and extending upward above Vs+h1) is clearly higher than the speed range permitted for the “S&R” mode (starting from the limiting speed Vs+h1 and extending downward to the baseline zero). To the extent the Examiner may be contending that “second predetermined vehicle speed range that is lower than the first predetermined vehicle speed range” necessarily implies that the first and second speed ranges cannot overlap, this is clearly negated by the fact that claim 1 explicitly states that the “upper limit of the second speed range is at least equal to the limiting speed,” i.e., the lowest possible value for the upper limit (Vs+h1) of the second speed range is the limiting speed (Vs), but Vs+h1 may be higher than Vs.

To the extent the Examiner contends that “an upper limit of the second speed range is at least equal to the limiting speed” is not enabled because the specification recites different values for the “upper limit” and the “limiting speed,” Applicants note that the claimed feature is fully consistent with the specification disclosure. First, “an upper limit of the second speed range is at least equal to the limiting speed” merely requires that the lowest possible value for the upper limit (Vs+h1) of the second speed range is the limiting speed (Vs), but Vs+h1 may be higher than Vs. In this regard, Fig. 2 of the specification clearly provides exemplary speed ranges which clearly satisfy the claimed feature, i.e., the upper limit Vs+h1 is higher (and therefore “at least equal to”) than the limiting speed Vs (the specification disclosure referring to Fig. 2 clearly provides “[a]s an example, let us assume that the limiting speed Vs is 30 km/h and that the hysteresis interval h1 is 5 km/h”).

For the foregoing reasons, Applicants submit that claim 1 and its pending dependent claims 2-3, 6-9 and 11-14 are in compliance with 35 U.S.C. § 112, second paragraph.

IV. Rejection of Claims 1-3, 6-9 and 11-14 under 35 U.S.C. § 102(e)

Claims 1-3, 6-9 and 11-14 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,658,344 ("Hirasago"). Applicants respectfully submit that Hirasago fails to anticipate pending claims 1-3, 6-9 and 11-14, for the reasons explained below.

To anticipate a claim under § 102(e), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 703 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

On page 9 of the Office Action, the Examiner indicated that "Applicant may overcome the rejection drawn to MPEP 2114 by adding the phrase "configured to" before the functional limitations. In response, Applicants have amended claim 1 in accordance with the Examiner's suggestions, i.e., amended claim 1 now recites: a) "an input device configured to receive . . ."; b) "a decision unit configured to determine . . ."; c) "the decision unit is configured to automatically cause a change from the first operating mode into second operating mode . . ."; and d) "the decision unit is configured to deactivate the speed controller when . . ." As implicitly acknowledged by the Examiner's statement that the rejection drawn to MPEP 2114 may be overcome by adding the phrase "configured to," the above-recited claimed features are clearly not taught or suggested by Hirasago. First, Hirasago clearly fails to teach or suggest that multiple

operating modes are distinguished with regard to the scope/number of speed-regulating functions. In addition, Hirasago clearly does not suggest that different transitions between operating modes are distinguished as a function of the scope/number of speed-regulating functions, i.e., Hirasago does not teach or suggest that “a change in a current operating mode which results in **the loss of a speed-regulating function occurs solely via a command of the driver to the input device.**” Furthermore, nothing in Hirasago teaches or suggests that, in the event of a change of the desired speed input by the driver, the decision unit decides whether this change is to be interpreted as a change of the operating mode. Still further, Hirasago clearly does not teach or suggest that “**the decision unit is configured to deactivate the speed controller when, in the second operating mode [for lower speed range], the speed of the vehicle increases, and the driver does not input a new desired speed, while the actual speed of the vehicle lies within a predefined speed range.**”

For the foregoing reasons, claim 1 and its dependent claims 2-3, 6-9 and 11-14 are not anticipated by Hirasago. Withdrawal of the anticipation rejection of pending claims 1-3, 6-9 and 11-14 is respectfully requested.

V. Conclusion

In view of the foregoing, it is submitted that claims 1-3, 6-9 and 11-14 are in allowable condition. It is therefore respectfully requested that the present application issue as early as possible.

Respectfully submitted,

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